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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/054,534

01/22/2002

Pradip Mukerji

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02/22/2005

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EXAMINER

SULLIVAN, DANIEL M

ART UNIT

PAPER NUMBER

1636

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/054,534

Applicant(s)

MUKERJI ET AL.

Examiner

Daniel M Sullivan

Art Unit

1636

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 01 February 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☒ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on 01 February 2005. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 2,4,5,11-16 and 36.  
Claim(s) withdrawn from consideration: 1,6-10 and 17-35.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

  
DAVID GUZO  
PRIMARY EXAMINER

Continuation of 3. NOTE: Claim 2, which was directed to an isolated nucleotide sequence comprising at least 70% nucleotide sequence identity to a nucleotide sequence comprising SEQ ID NO: 13, is amended such that it is now directed to an isolated nucleic acid sequence "encoding a polypeptide having at least 70% sequence identity to SEQ ID NO: 14, wherein said nucleic acid sequence encodes a functionally active D6-desaturase". The scope of the amended claim is significantly different from the scope of the examined claim because, due to the degeneracy of codon sequences, the genus of nucleic acids encoding a polypeptide having 70% identity with a reference polypeptide sequence is broader than the genus of nucleic acids having 70% identity with a reference nucleic acid sequence. Limitation of the claimed nucleic acid to encoding a functionally active D6-desaturase narrows the scope of the claim; however, it is not clear that a nucleic acid limited to having 70% sequence identity with SEQ ID NO: 13 would embrace all nucleic acids encoding a polypeptide having 70% identity with SEQ ID NO: 14 and exhibiting D6-desaturase activity. Although claim 36 was directed to a nucleic acid encoding a polypeptide having desaturase activity and at least 70% sequence identity with SEQ ID NO: 14, the polypeptide of the claim was also limited to having a third histidine box motif consisting essentially of QXXHH, while the amended claim 2 is not so limited. Thus, the scope of the amended claim 2 is different from, and appears to be broader than the scope of any of the previously examined claims. Therefore, entry of the proposed amendment would require additional consideration and/or search.

It is noted that the proposed amendments would appear to overcome the outstanding rejections with the exception of the double patenting rejection, which applicant has requested be held in abeyance until such time as allowable subject matter is indicated. It is further noted that, should Applicant file an amendment which places the product claims in condition for allowance, pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), process claims such as claims 25-30, will be rejoined IF THEY DEPEND FROM OR INCLUDE ALL OF THE LIMITATIONS OF THE ALLOWED PRODUCT CLAIMS. In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Amendments submitted after final rejection are governed by 37 CFR 1.116..